

REMARKS

The present application was filed on February 15, 2001, with claims 1-6, and claims the priority of U.S. Provisional Patent Application Serial No. 60/159,162 filed October 13, 1999. Claims 1-6 remain pending in the present application. Claim 1 is the only independent claim.

The Examiner has objected to the drawings. With regard to the objection to reference numeral 36 of FIG. 1, a replacement drawing sheet addressing the objection is submitted herewith. With regard to the objection to reference numeral 28 of FIG. 1, Applicants respectfully traverse on the ground that reference numeral 28 is in fact referred to in the specification at page 13, line 26, and in the Parts List at page 16.

Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,706,097 (hereinafter "Schelling") in view of U.S. Patent No. 6,686,958 (hereinafter "Watanabe").

Claim 5 stands rejected under §103(a) as being unpatentable over Schelling and Watanabe in view of U.S. Patent No. 6,445,412 (hereinafter "Shiohara").

Claim 6 stands rejected under §103(a) as being unpatentable over Schelling and Watanabe in view of U.S. Patent No. 5,848,420 (hereinafter "Xu").

In this response, Applicants traverse the §103(a) rejections. Applicants respectfully request reconsideration of the present application in view of the remarks below.

A proper *prima facie* case of obviousness requires that the cited references when combined must teach or suggest all the claim limitations, and that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references or to modify the reference teachings. See Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §706.02(j).

Applicants submit that the Examiner has failed to establish a proper *prima facie* case of obviousness in the §103(a) rejections of claims 1 to 6, in that the proposed combinations of references, even if assumed to be combinable, fail to teach or suggest all the claim limitations, and in that no cogent motivation has been identified

for combining the references or modifying the reference teachings to reach the claimed invention.

Independent claim 1 is directed to a method for accessing at least one image file transferred from a digital camera to a host computer by producing icons representative of portions of each image file. The image file includes a digital image and at least one audio data segment. The method includes, among other steps, the steps of coupling a digital camera memory to a host computer so that the host computer identifies the image file and recognizes the presence of the corresponding digital image and audio data segment in the memory, and producing at least two icons which are provided on a display associated with the host computer and which respectively represent the digital image and the audio data segment. The digital image icon or the audio data segment icon may be selectively accessed to cause the transfer of the digital image or the audio data segment from the memory to the host computer for access by a user.

In an illustrative embodiment of the invention, as described at page 14, lines 4-25, of the specification, a digital camera 10 comprises a removable memory card 30 that stores a captured image file comprising a digital image and an audio data segment. The digital camera 10 is connected to a host computer 40 via an interface cable 36. The host computer 40 identifies the captured image file stored in the removable memory card 30 and recognizes the presence of the associated digital image and audio data segment. FIG. 3B shows an example of a pair of icons corresponding to a digital image file P0000047. It can be seen that the audio data segment portion of the digital image file has its own separate icon, corresponding to a wave file denoted P0000047.wav.

The Examiner argues that the limitations of claim 1 are met by the combined teachings of Schelling and Watanabe. For the reasons identified below, Applicants respectfully disagree.

The collective teachings of Schelling and Watanabe fail to meet the limitations of claim 1. More specifically, the collective teachings of these references fail to teach or suggest a host computer that recognizes the presence of both a digital image and an audio data segment in a given image file stored in a digital camera

memory, and produces separate icons on its display for the digital image and the audio data segment. The Examiner relies on the icons 28, 30 and the display on CRT 53 in FIGS. 1 and 3 of Schelling, in combination with the “drag and drop” method of FIG. 8 of Watanabe. However, there is no provision in either Schelling or Watanabe for the claimed arrangement in which the host computer recognizes the presence of both a digital image and an audio data segment in a given image file stored in a digital camera memory, and produces separate transfer-causing icons as claimed.

As indicated in Schelling at column 2, lines 59-64, the icons 28 and 30 are simply “type indicator” icons of an index print, that is, icons which are assigned to indicate the type of files that are present in a given data file listed on an index print. The Examiner at page 3, paragraph 5, of the Office Action acknowledges that such type indicator icons are for purposes of providing a visual indication only, and cannot be selectively accessed to cause the transfer of any particular file from a memory to a host computer as claimed.

Schelling also teaches in column 3, line 62, to column 4, line 4, that an operator of the computer 50 must manually enter the type indicators corresponding to icons 28 and 30:

The operator, via an input device such as a keyboard 52, selects images from the data files for making thumbnail images and generates text for subject matter descriptors. The operator appends an index code and a type indicator to each subject matter descriptor to generate the index images, and arranges the index images for display on a CRT 53. When the index print 10 has been composed, the operator prints it on a printer 54, such as a thermal printer, connected to the PC 50.

This is believed to be a direct teaching away from the claimed invention, which as indicated above calls for the host computer to recognize the presence of both a digital image and an audio data segment in a given image file stored in a digital camera memory, and to produce separate icons on its display for the digital image and the audio data segment.

The Examiner argues that combination of the Schelling teachings with those of Watanabe will result in the claimed invention. However, as noted above, the icons 28 and 30 of Schelling relied on by the Examiner are simply visual indication icons, and not transfer-causing icons which when accessed will result in file transfer. The FIG. 8 portion of Watanabe relied on by the Examiner simply indicates that files can be transferred by dragging and dropping associated icons, and fails to overcome the fundamental deficiencies of Schelling as applied to claim 1. That is, there is no teaching in Watanabe regarding the claimed host computer recognizing the presence of both a digital image and an audio data segment in a given image file stored in a digital camera memory, and producing separate icons on its display for the digital image and the audio data segment. Elements 33 and 42 in FIG. 8 of Watanabe are described as “image data,” and thus it may reasonably be expected that only a single icon 33 or 42 would be used for a given image file, rather than separate transfer-causing icons for digital image and audio data segment portions of the given image file as in the claimed invention.

Accordingly, it is believed that the combined teachings of Schelling and Watanabe fail to meet the limitations of claim 1 relating to host computer recognition of both a digital image and an audio data segment in a given image file, and production of separate icons for the digital image and the audio data segment of the given image file.

Inasmuch as claim 1 includes limitations not taught or suggested by the combined teachings of Schelling and Watanabe, the Examiner has failed to establish a *prima facie* case of obviousness for this claim.

Also, as indicated previously, the Examiner has failed to identify a cogent motivation for combining the Schelling and Watanabe references or modifying the reference teachings to reach the claimed invention.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an

examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. There has been no showing in the present §103(a) rejection of objective evidence of record that would motivate one skilled in the art to combine the Schelling and Watanabe references to produce the particular limitations in question.

More specifically, the Examiner states as follows in the Office Action at page 4, first full paragraph, regarding independent claim 1 and the proposed combination of the Schelling and Watanabe references:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine the “drag and drop” method of Watanabe et al. with the invention of Schilling [sic] et al. to create a system of allowing the user select [sic] which images or audio clips to transfer from the memory by selecting the corresponding thumbnail to a host computer for the benefit of organizing the images and audio clips on the host computer by thumbnail while freeing limited storage of the camera.

Applicants submit that this statement is a subjective and conclusory statement of obviousness, and insufficient to support the proposed combination of the reference teachings. Also, as indicated previously, Schelling teaches the use of type indicator icons in an index print, and fails to teach or suggest transfer-causing icons, while Watanabe teaches the use of a single icon for a given image file. Thus, both Schelling and Watanabe not only fail to motivate the proposed combination, but actively teach away from it.

It therefore appears that the Examiner in formulating the §103(a) rejection of independent claim 1 over Schelling and Watanabe has undertaken a piecemeal reconstruction of the claimed invention based upon impermissible hindsight, given the benefit of the disclosure provided by Applicants.

The §103(a) rejection of claim 1 over the proposed combination of Schelling and Watanabe is believed to be improper, and should be withdrawn.

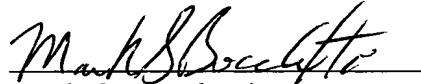
Dependent claims 2-6 are believed allowable for at least the reasons identified above with regard to independent claim 1. The Shiohara and Xu references cited by the Examiner fail to supplemental the fundamental deficiencies of the proposed combination of references as applied to the independent claim. In addition, the Examiner provides only conclusory statements of motivation for combining Shiohara or Xu with Schelling and Watanabe, and thus fails to establish a proper *prima facie* case for the additional combinations. See page 5, paragraph 3, and page 6, last paragraph, to page 7, first paragraph, of the Office Action.

In view of the foregoing, it is believed that the claims in the application are allowable over the prior art and such allowance is respectfully requested.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225.

A duplicate copy of this communication is enclosed.

Respectfully submitted,



Mark G. Bocchetti
Attorney for Applicant(s)
Registration No. 31,330

PRC:cjm
Telephone: (585) 477-0553
Facsimile: (585) 477-4646

Enclosures: Replacement Figure 1